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EXAMINER

NATNAEL, PAULOS M

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/725,456

Applicant(s)

TAKASHIMIZU ET AL.

Examiner

Paulos M. Natnael

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim **44** is rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,549,243 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

b) the claimed "an isolator coupled to the input terminal to isolate one packet of the video signal" is met by Claim 1, of patent '243, limitation "an isolator to isolate one video signal from a received said digital multiplexed signal".

c) the claimed "a decoder to detect the format of the isolated one packet of the video signal and to decode according to the predetermined standard", is met by claim 1, of

patent '243, the limitation "a decoder to decode the video signal from said isolator according to said encoding/decoding standard."

And, d) a video processor section which converts a decoded signal to an analog signal based on the detected format, and to output the converted analog signal, is met by Claim 1 of '243, limitation "a plurality of video processor sections, with respective video processor sections providing video processing according to a different video signal format of said plurality of different video signals formats."

Except for;

a) an input terminal capable of receiving a video signal of different formats with plural packets and coded by a predetermined standard;

Regarding a), claim 1 does not comprise this limitation, however, it would be obvious to the skilled in the art that without an input terminal capable of receiving a video signal of different formats, the steps or processing that followed in (b), (c), and (d) would not be done, i.e. the receiver would not be able to process the signals without an input terminal first receiving the said different formats. Thus, since this is an essential step, although it is not specifically disclosed by the claim, it implied and therefore such specific disclosure would not change the operation of the system as a whole.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims **24, 28-31, 35, 38 and 42, 44-46** are rejected under 35 U.S.C. 102(e) as being anticipated by **Goodman, U.S. 5,666,487**.

Considering claim **24**, Goodman et al. disclose all claimed subject matter, note;

a) a tuner to receive a multiplexed signal coded according to a predetermined format including a plurality of video signals for a plurality of different video signal formats, and to correct at least one predetermined type of error of the multiplexed signal, is met by tuner 901 and digital communication section 903, fig.9, comprising a QAM Demod & FEC. (See also the Title)

b) a processor to extract data of a subject video signal from the multiplexed signal, to decode the subject video signal according to the predetermined format, and to output the decoded signal as a video signal corresponding to a format as indicated in the data of the subject video signal, is met by digital audio/video processor 825, fig.8, comprising

MPEG demux 827, MPEG video and audio decoders, 829 and 831, respectively. (See also fig.7)

Considering claim **28**, **35** and **42**, the claimed a character unit for adding character information to at least one of the video signal and subject video signal, the character information indicated in the data of the subject video signal, is met by the Graphics Overlay Controller 833, fig.8. (Note that Character is also defined as “any symbol that requires one byte of storage. This includes all the ASCII and extended ASCII characters, including the space character. ***In character-based software, everything that appears on the screen, including graphics symbols, is considered to be a character.*** In graphics-based applications, the term character is generally reserved for letters, numbers, and punctuation.” --webopedia.com (see also Webster’s dictionary 10<sup>th</sup> edition)

Considering claim **29**, a digital broadcast receiver as claimed in claim 24, comprising a format-outputter to output in real-time, the type of format of the video signal being outputted from the digital broadcast receiver, is met by the encoder 837, fig.8;

Considering claim **30**, the claimed digital broadcast receiver as claimed in claim 24, where the digital broadcast receiver is a television-based accessory, is met by the NIM 201 and DET 202, figures 7-9.

Regarding claim **31**, a display unit for displaying a digital broadcast signal, comprising: a tuner to receive a multiplexed signal coded according to a predetermined format including a plurality of video signals for a plurality of different video signal formats, and to correct at least one predetermined type of error of the multiplexed signal; a processor to extract data of a subject video signal from the multiplexed signal, to decode the subject video signal according to the predetermined format, and to output the decoded signal as a video signal corresponding to a format as indicated in the data of the subject video signal; and a display which processes the video signal and displays the processed signal.

See rejection of claims 24 and 30;

Regarding claim **38**, see rejection of claims 24 and 31;

Considering claim **44**, a digital apparatus comprising:

a) an input terminal capable of receiving a video signal of different formats with plural packets and coded by a predetermined standard, is met by Processor 907, fig.8, comprising Packet processor.

b) an isolator coupled to the input terminal to isolate one packet of the video signal, is met by demultiplexer 827, fig.8;

c) a decoder to detect the format of the isolated one packet of the video signal and to decode according to the predetermined standard, is met by decoder 829, fig.8;

d) a video processor section which converts a decoded signal to an analog signal based on the detected format, and to output the converted analog signal, is met by audio/video processor 837, fig.8;

Regarding claim **45**, a digital apparatus as claimed in claim 44, wherein the video signal having the different formats is inputted to the input terminal;

see rejection of claim 44 (a);

Regarding claim **46**, a digital apparatus as claimed in claim 44, comprising an output terminal which outputs the converted analog signal and information of the detected format, is met by encoder 837, fig.8;

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **25-27, 29, 32-34,36,37,39-41,43** rejected under 35 U.S.C. 103(a) as being unpatentable over **Goodman, U.S. 5,666,487**.

Considering claim **25**, a digital broadcast receiver as claimed in claim 24, comprising a selectable encoder selectable to encode the subject video signal according to any of a



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plurality of video signal formats, and wherein the processor automatically selects the selectable encoder to output the video signal in an encoded format as indicated in the data of the subject video signal, is met by Encoder 837, fig.8; as to the encoder being selectable, Goodman does not specifically use the word "selectable", however, it is implied because Goodman discloses that the system would handle "...signals of different format to a user by multiplexing compressed broadband data with data of a different format into MPEG encoded data stream. (see title)

Regarding claim **26**, the claimed digital broadcast receiver as claimed in claim 24, where the processor has capability to output the video signal as an analog video signal having a predetermined number of scanning lines. The system of Goodman teaches a DAC converter included in the encoder 837. However, it would be obvious to the skilled in the art to modify the reference of Goodman and locate the DAC within the processor 825 instead, so that the NTSC encoder then would not have to be burdened with digital to analog conversion and would only deal with analog video signal.

Regarding claim **27**, a digital broadcast receiver as claimed in claim 24, where the multiplexed signal includes multiplexed video signals for both a standard definition format and a high definition signal format, is **implied** in the system of Goodman et al. Goodman et al. discloses a network providing signals of different format to a user by multiplexing compressed broadband data with data of a different format into MPEG encoded data stream.

Regarding claim **32** and **39**, see rejection of claim 25;

Regarding claim **33** and **40**, see rejection of claim 26;

Regarding claim **34** and **41**, see rejection of claim 27;

Regarding claim **36** and **43**, see rejection of claim 29;

Regarding claim **37**, see rejection of claim 30;

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Inoue et al (U.S. 5,832,085) discloses storing multiple protocol, compressed audio/video data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paulos M. Natnael whose telephone number is (703) 305-0019. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PMN  
March 1, 2005



**PAULOS M. NATNAEL**  
**PATENT EXAMINER**